

REMARKS

Status of the claims:

With the above amendments, claim 1 has been canceled, claim 2 has been amended, and claim 3 has been added. Claims 2-3 are pending and ready for further action on the merits. No new matter has been added by way of the above amendments. Support for the amendment to claim 2 can be found in original claim 1 and also at page 21, lines 6-11. Support for claim 3 can be found at page 6, lines 23-24. Reconsideration is respectfully requested in light of the following remarks.

Rejections under 35 U.S.C. §112, second paragraph

Claims 1 and 2 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. The Examiner asserts that no plant is known by the genus name "Butes". Applicant has canceled claim 1 so the rejection is moot with respect to that claim. Applicant has amended claim 2 to recite "Butea", which is a plant genus. Applicant believes that with this amendment that the rejection has been obviated. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 U.S.C. §102

Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by Pangsrivongse (Rev. Filipina Med. Farm., 1938, CAPLUS abstract), Schoeller '712 (US Patent No. 2,112,712) by Schoeller '397 (US Patent No. 2,136,397) or by Vatna (Thai Schi. Bull., 1939). Claim 1 has been canceled so this rejection is moot. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 U.S.C. §103

Claims 1 and 2 are rejected under 35 U.S.C. §103(a) as being unpatentable over Pangsrivongse (Rev. Filipina Med. Farm., 1938, CAPLUS abstract), the admitted state of the art, and the reference entitled "Thailand: Thai Equivalent Viagra Drug Unveiled" (source: Nation -PROMT Newsletter Abstract, March 24, 1999).

Applicant traverses.

The Examiner asserts that Pangsrivongse discloses extracting *Butea Superba* with an alcohol, that the specification discloses that it is well-known in the art that *Butea Superba* roots are used in Thailand to increase sexual potency, and that

another name for *Butea Superba* is red kwao krua. Finally, the Examiner asserts that the article, "Thailand: Thai Equivalent Viagra Drug Unveiled" discloses the beneficial effects of the red kwao-krua potency pill.

Applicant submits that nowhere is there a disclosure or a suggestion that the extract of *Butea Superba* will be able to treat erectile dysfunction. In particular, Applicant notes that the abstract for Pangsrivongse recites:

The root of this member of the Leguminosae is esteemed as a "rejuvenating drug" in Siam. Two glucosides were isolated from the alc. extract but the properties were not determined.

First, Applicant notes that the properties of the extract were not determined. Thus, one of ordinary skill in the art would not even know if the extract had the compounds in it necessary to be a "rejuvenating drug". The "rejuvenating drug" could have been in the part of the root that was not extracted because the properties of the extracted portion was never even determined.

Moreover, Pangsrivongse fails to disclose the method as is currently claimed (see claim 2). The reference, "Thailand: Thai Equivalent Viagra Drug Unveiled" fails to make up for these deficiencies. In particular, neither of the references disclose or suggest the series of steps in the method, i.e., the

method of drying, pulverizing, immersing, extracting and filtering as appears in currently amended claim 2. Thus, Applicant asserts that the Examiner has failed to make out a *prima facie* case of obviousness with regard to the 35 USC §103(a) rejection over Pangsrivongse, the admitted state of the art and the reference entitled "Thailand: Thai Equivalent Viagra Drug Unveiled". Three criteria must be met to make out a *prima facie* case of obviousness.

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- 2) There must be a reasonable expectation of success.
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP §2142 and *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). In particular, the Examiner has failed to meet the third element to make a proper *prima facie* obviousness rejection. As was pointed out above, neither of the cited references disclose or suggest all of the method steps as appears in currently amended claim 2. For this reason alone, withdrawal of the rejection is warranted and respectfully requested.

Moreover, the reference, "Thailand: Thai Equivalent Viagra Drug Unveiled" asserts that the use of *Bunea superba* is to produce more sperm and increase sexual potency. Applicant respectfully points out that producing more sperm and increasing sexual potency is not the same as a method of treating erection dysfunction or malfunction as is claimed in claim 2. Applicant respectfully submits that one of ordinary skill in the art would recognize that these are different problems. Moreover, in this regard, Applicant respectfully notes that the "Thailand: Thai Equivalent Viagra Drug Unveiled" reference is unaccompanied by any experimental data showing what is exactly meant by "increasing sexual potency". Thus, for this reason also, the rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

With the above remarks and amendments, it is believed that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

If any questions remain regarding the above matters, please contact the undersigned in the Washington metropolitan area at the phone number listed below.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicant hereby petitions for an extension of two (2) months to November 4, 2004 in which to file a reply to the Office Action. The required fee of \$430.00 is enclosed herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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